



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,914	08/20/2001	Nghi Van Nguyen	05725.0798-00	4346

7590 04/28/2003

Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

ELHILO, EISA B

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/931,914

Applicant(s)

NGUYEN ET AL. *g*

Examiner

Eisa B Elhilo

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 & 6. 6) ☐ Other: _____

Claims 1-36 are pending in this application.

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 35-37 been renumbered 34-36.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13, 15-27 and 29-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Cannell et al. (US 6,435,193 B1).

The applied reference has a common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Cannell (US' 193) teaches a method for lanthionizing keratin fibers comprising generating hydroxide ions in an ionizing solvent comprising at least one activating composition and at least one multivalent metal hydroxide. The at least one activating composition may further comprises at least one complexing agent effective for dissociating the at least one multivalent metal hydroxide in sufficient quantity to effect lanthionization of keratin fiber. A composition comprising the generated hydroxide ions can thereby be formed and the composition applied to keratin fibers. The lanthionization can be terminated when a desired level of relaxation of the keratin fibers is reached (see col. 7, lines 63-67 and col. 8, lines 1-12). Cannell also teaches complexing agents such as dihydroxy-carboxylic acids (see col. 5, lines 62-64), which can be represented by the claimed formula (1), when in the claimed formula (1), R_1 is carbonyl group, R_2 is chosen from CR group wherein R is hydrogen atom and X_1 and X_2 are both chosen from hydroxyl groups as claimed. Cannell further, teaches a method for lanthionizing keratin fibers comprising applying to the keratin fibers a composition comprising alkali metal hydroxides such as calcium hydroxide in the amount of 1% relative to the total weight of the composition which within the claimed range (see col. 2, line 24 and col. 7, lines 32-34), relaxers such as sodium hydroxide (see col. 2, lines 5-17), water as a solvent (see col. 8, lines 13-16), complexing agents in the form of organic and inorganic acid salts (see col. 5, lines 55-61), inorganic cations chosen from sodium, potassium and lithium (see col. 5, lines 60-61) and other additive such as proteins, polymers and silicones (see col. 7, lines 3-4). Cannell also teaches a multi-compartment kit for lanthionizing keratin fibers, wherein the kit comprises at least two separate compartments. One compartment of the kit comprises a composition for generating hydroxide ions that comprises at least one multivalent metal hydroxide while the other compartment of the kit comprises at least

one activating composition comprising at least one exchange composition for generating hydroxide ions as claimed (see col. 3, lines 3-11). Cannell teaches all the limitations of the claims. Hence, Cannell anticipates the claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannell et al. (US 6,435,193 B1) in view of Gott et al. (US 6,287,582 B1).

The disclosure of Cannell (US' 193) is summarized above. The reference does not teach or disclose mucic acid as claimed. However, the reference teaches and suggests a composition comprising dihydroxy-carboxylic acids (see col. 5, lines 62-64).

Gott (US' 582) teaches in analogous art a cosmetic composition comprising mucic acid (see col. 6, line 20).


Therefore, in view of the teaching of the secondary reference one having ordinary skill in the art at the time the invention was made would be motivated to modify the primary reference of Cannell by incorporating mucic acid as taught by Gott to make such a composition with the reasonable expectation of success because the prior art clearly teaches and discloses dihydroxy acids in the composition and, thus, a person of ordinary skill in the art would expect such a composition to have similar properties to those claimed. Absent unexpected results.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (703) 305-0217. The examiner can normally be reached on M - F (7:30-5:00) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Elhilo
April 17, 2003

GREGORY DELCOTTO
PRIMARY EXAMINER

